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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,337	01/20/2004	Rodney L. Pettis	025635.011.042	9813
35979	7590	10/13/2005	EXAMINER	
BRACEWELL & GIULIANI LLP			HON, SOW FUN	
P.O. BOX 61389			ART UNIT	
HOUSTON, TX 77208-1389			PAPER NUMBER	

1772

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/760,337

Applicant(s)

RÖDNEY PETTIS

Examiner

Sow-Fun Hon

Art Unit

1772

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attachment to advisory action.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☒ Other: Attachment to advisory action.

***Advisory Action***

1. The proposed amendment will not be entered because it presents additional claims without canceling a corresponding number of finally rejected claims, and is not deemed to place the application in better form for allowance for the reasons set forth below.

2. Applicant argues that the referred embodiment relates to a 5-layer film while Applicant's film is 3 layered.

Applicant is respectfully apprised that the term "comprising" in the presently claimed film includes other layers.

3. Applicant argues that Schirmer emphasizes the use of an adhesive after merely hinting at directly applying a single layer of SBC to a single layer of VLDPE.

Applicant is respectfully apprised that Schirmer discloses direct adherence as being a possibility just by claiming it (column 12, lines 34-45), and then claiming a second embodiment using the adhesive layer (column 12, lines 44-47).

4. Applicant argues that nothing in the brief mention of direct adherence of an SBC to a VLDPE teaches or suggests that more than two layers may be directly adhered to each other.

Applicant is respectfully advised that it only takes two layers to adhere to each other at the interface of the two layers, and that it is common sense that an identical interface on the other side of the VLDPE layer will have the same directly adhering properties, to form a sandwich.

5. Applicant argues that the disclosure of Schirmer in emphasizing the adhesive layer teaches that the invention of Schirmer is more likely to work if an adhesive layer is used.

Again, Applicant is respectfully advised that Schirmer not only fails to teach against not using an adhesive layer, Schirmer discloses direct adherence as being a possibility just by claiming it (column 12, lines 34-45), and then claiming a second embodiment using the adhesive layer (column 12, lines 44-47).

6. Applicant argues that it would be counterintuitive to one skilled in the art to add additional layers to the embodiment comprising a single layer of VLDPE and a single layer of SBC as this would increase the total thickness of the SBC layering structure, which would diminish the elasticity of the film.

Applicant is respectfully requested to refer to the specific citations of Schirmer in order to clarify Applicant's conclusions regarding the elasticity, gloss, clarity and other optical properties of the film as delineated by Applicant to be the subject of comparison by Schirmer.

7. Applicant argues that the invention of Applicant allows for a more economical film to manufacture without a reduction in clarity or strength, as opposed to the film comprising adhesive layers.

Applicant is respectfully apprised that this feature is not present in the claims.

8. Applicant argues about the adverse effect of an adhesive layer.

Applicant is respectfully reminded that Schirmer not only fails to teach against not using an adhesive layer, Schirmer discloses direct adherence as being a possibility just

by claiming it (column 12, lines 34-45), and then claiming a second embodiment using the adhesive layer (column 12, lines 44-47).

9. Applicant argues that the Office has ignored the intermediate adhesive layers of Schirmer in determining similarity of composition in the expectancy of similar physical properties.

Applicant is respectfully reminded that Schirmer not only fails to teach against not using an adhesive layer, Schirmer discloses direct adherence as being a possibility just by claiming it (column 12, lines 34-45), and then claiming a second embodiment using the adhesive layer (column 12, lines 44-47). Therefore, because the first claimed embodiment is the same, the compositions are the same.

10. Applicant argues that claim 4 of Schirmer also states that the SBC layers are about 8% of the total film thickness which would bring the sizes of the layers outside Applicant's ranges.

Applicant is respectfully advised that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed structure and a structure having the claimed relative dimensions would not perform differently than the prior art structure, the claimed structure was not patentably distinct from the prior art structure. See MPEP 2144.04 IV. A.

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (571)272-1492. The examiner can normally be reached Monday to Friday from 10:00 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571)272-1498. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*S. Hon.*

Sow-Fun Hon

*10/05/05*

*[Signature]*

HAROLD PYON

SUPERVISORY PATENT EXAMINER

*1772*

*10/6/05*